

## REMARKS/ARGUMENTS

### *Claim Rejections - 35 USC § 103*

1. The Examiner rejected claims 1-22 under §103(a) as being unpatentable (obvious) over Lyle (U.S. Patent No. 2,347,273) in view of Sears (U.S. Patent No. 5,671,543).
2. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” MPEP § 706.02(j).
3. **Claims 1-6.** Claim 1 is an independent claim having claims 2-6 depending there-from. Claim 1 has been amended to better define that the reference mark points at marking indicia on the lower face which denotes or relates to the measurement of distance from the free end to the marking device (which itself is adjacent the opening). Lyle (nor Sears) shows a top window with a reference mark that points to the measurement to the marking device (Lyle shows the measurement to the rear of the case, not the front of the case where the opening and marking device is (on the present invention). As such, the references (when combined) do not teach all of the claim limitations and as such claims 1-6 are allowable.
4. **Claims 7-12.** Claim 7 is an independent claim having claims 8-12 depending there-from. Claim 7 has been amended to better define that the present invention (as claimed in that set of claims) includes first and second reference marks, the first reference mark pointing to a marking indicia on the first side which denotes the measurement of distance from the free end, the second reference mark pointing at second marking indicia on the second side which denotes the measurement of distance from the free end. The combination of Lyle and Sears does not show this. As such, the references (when combined) do not teach all of the claim limitations and as such claims 7-12 are allowable.
5. **Claims 13-20.** These claims have been cancelled.

6. **Claims 21-22.** Claim 21 is an independent claim having claim 22 depending there-from. Claim 21 includes the limitation that "each scale being reversed relative to the other scale so that, if the number of one scale could be seen by transparency through the other scale they would be reversed in orientation." The reason this reversal is non-obvious is provided in paragraph [0107] of the specification. The references do not disclose this reversal, and therefore fail to teach all of the limitations of the claims. As such, claims 21 and 22 are allowable over the cited references.

***Double Patenting***

Claims 1-22 were rejected under the judicially created doctrine of obviousness type double patenting over claims 1-3 of U.S. Patent No. 6,701,636 in view of Lyle (U.S. Patent No. 2,347,273). Applicant encloses herewith a Terminal Disclaimer and Statement under 37 CFR 3.73(b) overcoming said rejection.

***USPN 3,253,531***

The Examiner asked Applicant to provide the correct patent number for the Eberhart reference for consideration. U.S. Pat. No. 3,253,531 is the Eberhart patent, but upon further review Applicant believes that its submission in the IDS was in error. Please disregard said patent.

***Conclusion***

If the Examiner feels it would advance the application to allowance or final rejection, the Examiner is invited to telephone the undersigned at the number given below.

Reconsideration and allowance of the application as amended is respectfully requested.

DATED this 24<sup>th</sup> day of February 2005.

Very respectfully,



---

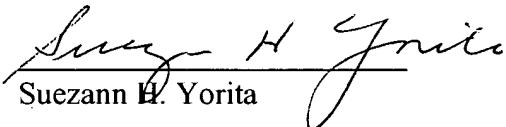
STEPHEN M. NIPPER  
Reg. No. 46,260  
(208) 345-1122

CERTIFICATE OF MAILING

I HEREBY CERTIFY that this correspondence is being deposited with the United States Postal Service on the below date as first class mail in an envelope addressed to:

Mail Stop Amendment  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

DATE: February 24, 2005

  
Suezann H. Yorita